

Remarks

The Applicant respectfully requests reconsideration and withdrawal of the rejections of record in view of the amendments and remarks in this paper.

Before addressing the substance of this communication, the Applicant respectfully points out that this case was made special by the petition decision of July 25, 2005, due to the Applicant's age. The Office is requested to make a special effort to promptly conclude prosecution in this matter.

Drawings

Formal drawings are being filed with this amendment addressing the informalities of the drawings previously provided.

35 USC § 101

The Examiner is respectfully requested to withdraw the rejection of method claims 1, 5-20, 23-29, and 50-59 on the theory of non-statutory subject matter. The present claims are patentable subject matter, as they involve a transformation of physical objects which are the underlying subject matter of the claim – medical records – from one state or thing to another, as “by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting” them. The present claims thus comply with *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, 75 Fed. Reg. 43922 (July 27, 2010) (“*Bilski* factors”).

For example, Limitation B of claim 1 is:

the service provider that is not the patient or a covered entity inducing said patient to convert said received medical record to a converted medical record in a storage format that is not a medical record from a covered entity by summarizing, abstracting, retyping, redacting,

supplementing, or organizing the medical record, without the service provider modifying the information or its format in the received or converted medical record, wherein said storage format is different from said first format....

The Examiner correctly points out that this claim calls for the service provider to induce the patient to convert the medical record to a different state or thing, rather than the service provider itself doing the conversion. But that does not make the transformation in question one that "contributes only nominally or insignificantly to the execution of the claimed method (e.g., in a data gathering step or in a field-of-use limitation)." This is an important limitation of the invention, as explained in the present specification, for example at ¶ 0017 and 0033:

[0017] This acquisition step relies on the provisions of HIPAA that an individual is permitted to change the information in his or her own records, and can give the information in whole or in part to anyone else, without restriction on the patient or the recipient, even if the information is copied or derived from a confidential medical record of the patient. Neither the patient nor the recipient becomes a "covered entity," "business associate" of a covered entity, or is otherwise restrained from further disclosing or making use of the information as the result of receiving a patient's medical record from the patient.

* * *

[0033] The present invention is unique in that it emphasizes immediacy of information retrieval by a patient or the patient's representatives and it emphasizes the absolute patient control of

the information recording process. The present invention involves constructing a file system from the ground up (the patient) as opposed to a top down (physicians, hospitals, pharmacies, or other health care providers) approach. These unique characteristics of the present invention will exempt an Internet medical storage system based on the present invention from HIPAA, because such a system is neither a covered entity nor a business associate of a covered entity as defined by HIPAA and other regulations.

In other words, it is important that the patient modifies the medical record and the service provider does not, so the resulting medical record is not subject to the strictures of HIPAA that inhibit its timely use by an emergency care physician.

A more detailed analysis of the *Bilski factors* follows. Nothing in the *Bilski* factors requires that the “transformation” indicating patentable subject matter must be carried out directly by the person practicing the claim. Note that all of the *Bilski* factors are addressed in order below, but the present invention is best qualified under the “transformation” analysis of part B, as opposed to the “machine” analysis of part A, of the *Bilski* factors. The “law of nature” analysis of part C is not applicable, as the present claims are an instance of “transformation” under part B. The “general concept” analysis of part D is not applicable, as no such “general concept” is believed to be recited in the present claims.

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| A. Whether the method involves or is executed by a particular machine or apparatus. If so, the claims are less likely to be drawn to an abstract idea; if not, they are more likely to be so drawn. Where a machine or apparatus is recited or inherent in a patent claim, the following factors are relevant: | The present method involves a particular apparatus. Claim 1 recites "storing said converted medical record in a memory." A memory is an apparatus necessarily involved in the claim. |
| (1) The particularity or generality of the elements of the machine or apparatus; <i>i.e.</i> , the degree to which the machine in the claim can be specifically identified (not any and all machines). Incorporation of a particular machine or apparatus into the claimed method steps weighs toward eligibility. | A memory is very particular apparatus -- a thing that stores information -- so this factor "weighs toward eligibility." |
| (2) Whether the machine or apparatus implements the steps of the method. Integral use of a machine or apparatus to achieve performance of the method weighs toward eligibility, as compared to where the machine or apparatus is merely an object on which the method operates, which weighs against eligibility. | The memory of claim 1, which is apparatus, implements steps of the method of claim 1, such as: "storing said converted medical record in a memory." |

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| (3) Whether its involvement is extra-solution activity or a field-of-use, <i>i.e.</i> , the extent to which (or how) the machine or apparatus imposes meaningful limits on the execution of the claimed method steps. Use of a machine or apparatus that contributes only nominally or insignificantly to the execution of the claimed method (<i>e.g.</i> , in a data gathering step or in a field-of-use limitation) would weigh against eligibility. | The involvement of the memory apparatus is not mere extra-solution activity or a mere field of use. If the memory is not employed, steps of the method (storing a converted medical record and conveying it to someone as directed by the patient) cannot be carried out. |
| B. Whether performance of the claimed method results in or otherwise involves a <u>transformation of a particular article</u> . If such a transformation exists, the claims are less likely to be drawn to an abstract idea; if not, they are more likely to be so drawn. Where a transformation occurs, the following factors are relevant: | Performance of the claimed method results in or otherwise involves a transformation of a particular article – a medical record. Specifically, claim 1 recites that a medical record is “convert[ed] ... to a converted medical record in a storage format that is not a medical record from a covered entity by summarizing, abstracting, retyping, redacting, supplementing, or organizing the medical record, ... wherein said storage format is different from said first format...” |
| (1) The particularity or generality of the transformation. A more particular transformation would weigh in favor of eligibility. | The transformation of a medical record from one physical format to another is a very particular transformation. |
| (2) The degree to which the recited article is particular; <i>i.e.</i> , can be specifically identified (not any and all articles). A transformation applied to a generically recited article would weigh against eligibility. | The article recited is a stored medical record, which is a concrete and very particular type of article. |

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| (3) The nature of the transformation in terms of the type or extent of change in state or thing, for instance by having a different function or use, which would weigh toward eligibility, compared to merely having a different location, which would weigh against eligibility. | As a result of the transformation, the converted medical record has “a different function or use:” it is formatted to be more quickly and effectively used by emergency medical personnel, compared to an ordinary medical record which is in multiple, voluminous documents and not organized or prioritized for quick understanding or review. |
| (4) The nature of the article transformed, <i>i.e.</i> , whether it is an object or substance, weighing toward eligibility, compared to a concept such as a contractual obligation or mental judgment, which would weigh against eligibility. | A medical record stored in a memory is an object. |
| (5) Whether its involvement is extra-solution activity or a field-of-use, <i>i.e.</i> , the extent to which (or how) the transformation imposes meaningful limits on the execution of the claimed method steps. A transformation that contributes only nominally or insignificantly to the execution of the claimed method (<i>e.g.</i> , in a data gathering step or in a field-of-use limitation) would weigh against eligibility. | The transformation of a medical record according to the claim imposes meaningful limits on the execution of the claimed method steps. If the medical record is not transformed, it lacks the utility of an emergency medical record. |
| C. Whether performance of the claimed method involves an application of a law of nature, even in the absence of a particular machine, apparatus, or transformation. If such an application exists, the claims are less likely to be drawn to an abstract idea; if not, they are more likely to be so drawn. Where such an application is present, the following factors are relevant: | This factor is not relevant in the particular case, since the claim clearly recites a transformation of an article to a different state or thing. |

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| (1) The particularity or generality of the application. Application of a law of nature having broad applicability across many fields of endeavor weighs against eligibility, such as where the claim generically recites an effect of the law of nature or claims every mode of accomplishing that effect, such that the claim would monopolize a natural force or patent a scientific fact. (As an example, claiming “the use of electromagnetism for transmitting signals at a distance.”) | This factor is not relevant in the particular case, since the claim clearly recites a transformation of an article to a different state or thing. |
| (2) Whether the claimed method recites an application of a law of nature solely involving subjective determinations; e.g., ways to think about the law of nature. Application of a law of nature to a particular way of thinking about, or reacting to, a law of nature would weigh against eligibility. | This factor is not relevant in the particular case, since the claim clearly recites a transformation of an article to a different state or thing. |
| (3) Whether its involvement is extra-solution activity or a field-of-use, i.e., the extent to which (or how) the application imposes meaningful limits on the execution of the claimed method steps. An application of the law of nature that contributes only nominally or insignificantly to the execution of the claimed method (e.g., in a data gathering step or in a field-of-use limitation) would weigh against eligibility. | This factor is not relevant in the particular case, since the claim clearly recites a transformation of an article to a different state or thing. |
| | |

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| D. Whether a general concept (which could also be recognized in such terms as a principle, theory, plan or scheme) is involved in executing the steps of the method. The presence of such a general concept can be a clue that the claim is drawn to an abstract idea. Where a general concept is present, the following factors are relevant: | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |
| (1) The extent to which use of the concept, as expressed in the method, would preempt its use in other fields; <i>i.e.</i> , that the claim would effectively grant a monopoly over the concept. | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |
| (2) The extent to which the claim is so abstract and sweeping as to cover both known and unknown uses of the concept, and be performed through any existing or future-devised machinery, or even without any apparatus. | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |
| (3) The extent to which the claim would effectively cover all possible solutions to a particular problem; <i>i.e.</i> , that the claim is a statement of the problem versus a description of a particular solution to the problem. | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| (4) Whether the concept is disembodied or whether it is instantiated; <i>i.e.</i> , implemented, in some tangible way. Note, however, that limiting an abstract idea to one field of use or adding token post solution components does not make the concept patentable. A concept that is well instantiated weighs in favor of eligibility. | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |
| (5) The mechanism(s) by which the steps are implemented; <i>e.g.</i> , whether the performance of the process is observable and verifiable rather than subjective or imperceptible. Steps that are observable and verifiable weigh in favor of eligibility. | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |
| (6) Examples of general concepts include, but are not limited to: | This factor is not relevant in the particular case, since the claim is not believed to recite a “general concept.” |
| • Basic economic practices or theories (<i>e.g.</i> , hedging, insurance, financial transactions, marketing); | This factor is not relevant in the particular case, since the claim is not believed to recite basic economic practices or theories (<i>e.g.</i> , hedging, insurance, financial transactions, marketing); |
| • Basic legal theories (<i>e.g.</i> , contracts, dispute resolution, rules of law); | This factor is not relevant in the particular case, since the claim is not believed to recite basic legal theories (<i>e.g.</i> , contracts, dispute resolution, rules of law). The claim does involve entering into a very specific type of contract, which is too specific to be a general concept. |

| <i>Bilski</i> Factors To Be Considered in an Abstract Idea Determination of a Method Claim | How the <i>Bilski</i> Factors Relate to the Present Case |
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| • Mathematical concepts (<i>e.g.</i> , algorithms, spatial relationships, geometry); | This factor is not relevant in the particular case, since the claim is not believed to recite mathematical concepts (<i>e.g.</i> , algorithms, spatial relationships, geometry); |
| • Mental activity (<i>e.g.</i> , forming a judgment, observation, evaluation, or opinion); | This factor is not relevant in the particular case, since the claim is not believed to recite mental activity (<i>e.g.</i> , forming a judgment, observation, evaluation, or opinion); |
| • Interpersonal interactions or relationships (<i>e.g.</i> , conversing, dating); | This factor is not relevant in the particular case, since the claim is not believed to recite interpersonal interactions or relationships (<i>e.g.</i> , conversing, dating); |
| • Teaching concepts (<i>e.g.</i> , memorization, repetition); | This factor is not relevant in the particular case, since the claim is not believed to recite teaching concepts (<i>e.g.</i> , memorization, repetition); |
| • Human behavior (<i>e.g.</i> , exercising, wearing clothing, following rules or instructions); | This factor is not relevant in the particular case, since the claim is not believed to recite human behavior (<i>e.g.</i> , exercising, wearing clothing, following rules or instructions); |
| • Instructing “how business should be conducted,” <i>Bilski</i> , slip op. at 12. | This factor is not relevant in the particular case, since the claim is not believed to recite instructing “how business should be conducted.” |

In sum, a very thorough analysis of the pertinent *Bilski* factors shows that the present claims plainly recite statutory subject matter. Therefore, the present rejection under 35 U.S.C. 101 should be withdrawn.

35 U.S.C. § 112

Responsive to the rejection under 35 U.S.C. § 112, claim 64 has been amended by changing “method” to “system.” This makes the terminology consistent, and does not change the scope of claim 64.

35 U.S.C. § 103(a) (Obviousness)
Segal in view of Joao and Official Notice

Claims 1, 19, and 30 and their dependent claims 5-18, 20-29, and 31-64 are pending in the present application. These claims have been rejected as being unpatentable over Segal in view of Joao and in view of Official Notice, in some cases including additional references. These rejections are respectfully traversed and urged to be withdrawn in view of the present amendments and remarks.

First, Segal does not show the requirements of claim 1, or of claims 19 and 30 that are rejected for the same reasons as claim 1.

Element B of claim 1 requires:

B. the service provider that is not the patient or a covered entity inducing said patient to convert said received medical record to a converted medical record in a storage format that is not a medical record from a covered entity by summarizing, abstracting, retyping, redacting, supplementing, or organizing the medical record, without the service provider modifying the information or its format in the received or converted medical record, wherein said storage format is different from said first format;

The Office action relies on Paragraphs [0027] and [0028] of Segal, which respectively state:

[0027] Once the patient is registered, the present invention provides means for entering data into the patient's medical record. The data is in three primary forms: 1) textual records; 2) scanned records, such

as EKGs and special reports; and 3) medical images, such as x-rays. With guidance from the patient-physician partnership described above, an authorized user, who may be, for example, the patient, a relative of the patient, or the patient's physician, enters textual information through an online Internet connection that interfaces with the GUIs and the web server. The web server stores in the clinical database the textual data received through the GUIs. For scanned records, the scanner (or a facsimile machine) digitally encodes the original documents and stores the encoded files in the clinical database. For medical images, which require diagnostic quality (significantly higher than the quality required for the scanned documents), the digitizer digitally encodes an original medical image in a high-resolution format file. The image server receives the file and transmits the file to the archives for storage.

[0028] With the data entered into the medical record, the present invention further provides means to retrieve and transmit the medical data. A user with authorized access to the medical record (e.g., the patient or her relative or primary physician) interfaces through an online Internet connection with the GUIs provisioned on the web server. The GUIs prompt the user to initiate a query to the web server for the desired medical record. If the desired record is a textual document or a scanned document, the web server consults the clinical database, retrieves the record, and transmits it back to the user. If the desired record is a diagnostic-quality image, then the web server queries the image server to retrieve the diagnostic-quality image from the archives. The image server returns the medical record to the web server and the web server transmits the record

back to the user. If the size of the digitally encoded file for the diagnostic-quality image is too large for efficient Internet transmission or the user does not have hardware capable of supporting diagnostic-quality resolution, the present invention also provides means for printing a hard copy of the image (e.g., a laser printer) and returning the hard copy to the user by conventional means, e.g., U.S. Mail. For each of these record retrieval methods, the present invention can return the record to the user or to a destination chosen by the user (e.g., a distant medical specialist for a referral or second opinion).

These paragraphs of Segal do not disclose “inducing said patient to convert said received medical record to a converted medical record,” as claim 1, element B, requires. The patient is indicated to be able to enter text into the medical record, but there is no indication this text is a modification of a medical record possessed by the patient.

These paragraphs of Segal also do not disclose inducing the patient to provide “a converted medical record in a storage format that is not a medical record from a covered entity.” The passages of Segal specifically contemplate that the patient will enter text into a medical record of a covered entity. Segal expressly states that: “the present invention provides means for entering data into the patient's medical record.” Segal, Par. [0027].

Element C of claim 1 recites:

C. the service provider that is not the patient or a covered entity receiving said converted medical record from said patient in said storage format;

The Office action cites in response Paragraph [0012] of **Segal**, which states:

[0012] Telemedicine is the use of computers, the Internet, and other communication technologies to provide medical care to patients at a distance. Early forms of this technology involved a simple intranet connection between a hospital and the home of a doctor to facilitate immediate preliminary diagnoses and initial courses of treatment for critical patients brought into the hospital. Later generations of telemedicine incorporated the Internet as a means for distributing medical records to specialists throughout the world for quick and convenient medical referrals. The latest iteration of telemedicine stores medical records and images such as x-rays on the Internet, for access and assessment by physicians such as radiologists. However, this practice of reviewing medical images online, referred to as teleradiology, is generally limited to preliminary "reads" to determine if further investigation is required, and is not suitable for full diagnoses.

Segal as relied upon by the Office action does not show what Element 1D requires:

the service provider that is not the patient or a covered entity receiving said converted medical record from said patient in said storage format.

Paragraph [0012] relied on to show this element does not disclose receipt of anything, much less a "converted medical record," by any service provider that is not a "covered entity." Physicians involved in treatment of the patient are covered entities. Additionally, the cited part of Segal contemplates that the specialist will receive the original medical record, not a modification by the patient.

Regarding **elements D-F of claim 1**, the Office action at page 7 acknowledges that “Segal, however, fails to expressly disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996.” Specifically, the Office action indicates that Segal fails to show steps (D), (E), or (F) of claim 1. (Office action, pp. 7-8.)

Joao does not teach or make obvious the missing elements D through F of claim 1, either.

Element D of claim 1 is:

D. the service provider that is not the patient or a covered entity storing said converted medical record in a memory that is not a medical record received from a covered entity in a form from which said converted medical record can be reproduced in said storage format;

The Office action relies on the following three passages of Joao as supposedly showing this element:

Joao, col. 2, lines 26-30.

The present invention provides an apparatus and methods for providing healthcare information and/or healthcare-related information which overcomes the shortcomings of the prior art.

This statement says nothing about the subject matter of element D of claim 1.

Joao, col. 3, lines 25-45

The apparatus also includes an intermediary communication device or computer which is associated with an intermediary, a broker, an agent, and/or any other individual and/or entity, that can utilize the present invention in order to act for and/or on behalf of any other individual, party, or entity, described herein. The intermediary computer(s) can communicate with, and operate in conjunction with, central processing computer and any of the other computers and/or computer systems described herein.

Each of the central processing computer(s), the provider computer(s), the payer computer(s), the patient computer(s), and/or the intermediary computer(s), can transmit information to, as well as receive information from, any of the computers described herein. In this regard, each of the computers can communicate with, process information from, and/or share data and/or information with, each other and/or any other computer or computers described herein and/or utilized in conjunction with the present invention. In this manner, data and/or information transfer between any of the computers can take place in a bi-directional manner.

The applicant will agree that this passage of Joao allows the possibility that the operator of an intermediary computer, who apparently is being interpreted as the "service provider" of claim 1, might be able to receive and store information from any other computer, such as that of the patient. But this passage of Joao does not disclose other limitations of element D, such as "storing said converted medical record in a memory that is not a medical record." If the intermediary computer and all other contributing computers, like that of the

physician or “provider” and the insurance company or “payer,” have mutual access to each other and the central computer, the whole network, including the memory of the intermediary computer, constitutes memory that is a medical record from a covered entity and thus outside the claim.

This passage of Joao also does not disclose the claim 1D limitation of “storing said converted medical record ... in a form from which said converted medical record can be reproduced in said storage format.” The passage provides no information about storing the converted medical record in any particular form.

Joao, col. 4, lines 26-33.

The apparatus and method of the present invention can be utilized in numerous preferred embodiments in order to provide a vast array of healthcare and healthcare-related services for any one or more of the various parties described herein. Any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner.

This part of Joao again is so general as not to disclose anything other than that an intermediary might have access. Again, it does not disclose the Claim 1D limitations of “storing said converted medical record in a memory that is not a medical record” or “storing said converted medical record ... in a form from which said converted medical record can be reproduced in said storage format.”

Thus, the parts of Joao relied upon in the Office action to show Element 1D do not show all the limitations of Element 1D.

Element 1E of Claim 1

Neither Joao nor any other prior art is used in the Office action to show the limitations of **Element E of claim 1**. The Office action relies only on the following statement of Official Notice as addressing Element E of claim 1:

Official Notice: Examiner takes Official Notice that the technique of having one party (e.g., intermediary, middle man, straw man, etc.) perform certain actions on behalf of another party through an agreement is notoriously well known and obvious. For example, a power of attorney, a proxy agreement, and executor/trustee agreements, are commonly used to obtain an agreement in advance between multiple parties to consummate an agreed course of action (e.g. transmission of medical records, etc.). Moreover, these techniques were developed and used prior to Applicant's invention to facilitate transactions.

In response, the applicant will first address generally the indication in the Office action that the use of Official Notice in the Office action was upheld by the Board of Patent Appeals and Interferences in its decision mailed February 26, 2010 ("Decision"). The Decision did not uphold, or even address the merits of, the Official Notice.

In the text bridging pages 3 and 4 and elsewhere, the Decision recites the rejection as stated by the Examiner, including the parts relying on Official Notice. But the Decision never discusses or decides whether the Official Notice in the appealed Office action was justified. The Decision relies entirely on the Board's own reasoning, which never mentions Official Notice, to affirm the rejections on new grounds. Decision, e.g. pp. 18-19.

Next, the applicant continues to object to the use of Official Notice in the present rejections, for the reasons previously and presently made of record. See Section 2144.03 MPEP, 8th Ed., Rev. 8 (2010):

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

No Examiner involved with this application has shown that the facts asserted as Official Notice are “capable of instant and unquestionable demonstration as being well-known.” Official Notice is being used because no prior art has been found showing certain elements of the invention, indicating plainly that the invention is non-obvious.

Respecting the above-quoted statement of Official Notice, the Applicant agrees that it is known generally for an agent to agree in advance with a principal to do something for the principal under certain specified future conditions. Some of the specific examples in the Office action – a power of attorney, a proxy agreement, or an executor/trustee agreement – are well-known examples of this technique. But these relate to financial transactions. The Applicant specifically disputes that this technique is unquestionably well known in the medical field for forwarding medical records under all the conditions defined in the present claims.

Keep in mind that the present claims require an agreement between a patient and a service provider (remembering that the service provider is not a physician or medical facility of any kind). The agreement is that the service provider will forward medical records received from the patient to someone else under certain circumstances. Medical records are routinely created and maintained by medical facilities or practitioners. The applicant submits it was not well-known

before the present invention was made for patients to make such agreements *with a service provider other than the physician* who has the original records. Why would it be obvious and well-known for the patient to agree with a service provider that is not a physician treating him or her to transmit a treating physician's medical records to a third party, given that records obtained from the service provider would normally be considered unreliable by the recipient? The answer to this question is in the present patent application, but not in the prior art.

Compare this situation to a somewhat similar case of a student wanting to send an official transcript of his college work to a third party, given that the college will only provide an official transcript directly to a third party, and only if the student directly requests it. If the student wanted to have a third party receive the information in the official transcript, it would not make sense for the student to modify the information in the transcript to create a new record, then contract with a service provider to take the modified record supplied by the student to the third party. The third party would have no basis to know whether the information in the modified record was genuine. If the modified transcript would suffice, the student would simply send it to the third party. If the modified transcript would not suffice, the third party would not receive the required information in this way. If the third party requested a transcript directly from the college, it would be refused. Clearly, the only well-known path forward would be for the student to request the college to forward an official transcript to the third party.

Somewhat similarly, in the present case the well-known path is that the patient wanting a third party to have his medical record would direct the physician possessing the record to forward the record to the third party in question. It is not well-known beyond question for the patient to take the record, modify it, and then engage a third party to forward the modified record to the third party under the defined circumstances of claim 1.

Additionally, the statement of Official Notice applied to claim 1E – the only information cited against claim 1E – does not show all the limitations of claim 1E. Element E of claim 1 recites:

E. the service provider that is not the patient or a covered entity obtaining agreement in advance with the patient that the service provider shall transmit said converted medical record to a third party in the storage format as received from the patient under defined conditions....

The statement of Official Notice recited above does not provide any indication that the prior art includes a service provider transmitting a converted medical record ... in the storage format as received from the patient to a third party under defined conditions. Keep in mind that, according to claim 1B, the converted medical record is in a storage format different from the format of the record originally obtained from a physician. Again, why would anyone send a modified version of the official record, rather than the official record itself? Again, the answer is in the present application, not the prior art.

In view of this traversal of the Official Notice, the Applicant relies on MPEP § 2144.03 (C), which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.

Therefore, the Examiner is respectfully requested to provide documentary evidence documenting the subject matter previously introduced by Official Notice, if this rejection is maintained.

Claim 1, Element F, recites:

F. the service provider that is not the patient or a covered entity transmitting said converted medical record to a third party in the storage format as received from the patient when the defined conditions occur.

The Office action relies on Figure 1 and two text passages of Joao in search of support for this limitation, as detailed below.

Joao, Figure 1 follows:

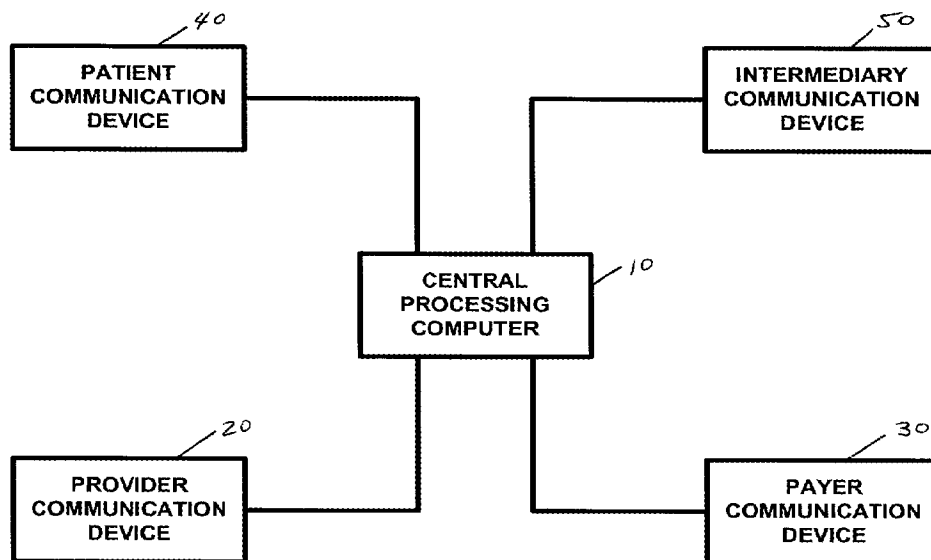


FIG. 1

This pure apparatus block diagram does not illustrate any method step, such as that the “intermediary” 50 of Joao Figure 1 or service provider of present claim 1:

- “is not the patient or a covered entity” or
- will be “transmitting said converted medical record to a third party in the storage format as received from the patient,” or

- will be “transmitting said converted medical record . . . when the defined conditions occur.”

Joao, col. 14, lines 34-48 is very similar to the above-quoted passage of col. 3, and discloses:

The apparatus 1 also includes an intermediary communication device or computer 50 (hereinafter referred to as "intermediary computer 50") which is associated with an intermediary, a broker, an agent, and/or any other individual and/or entity, that can utilize the present invention in order to act for and/or on behalf of any other individual, party, or entity, described herein. Any number or amount of intermediary computers 50 can be utilized in conjunction with an intermediary and/or group of intermediaries. The intermediary computer(s) 50 can communicate with, and operate in conjunction with, the central processing computer 10 and any of the other computers and/or computer systems associated with any of the other individuals and/or entities which utilize and/or operate in conjunction with the present invention.

This passage does not disclose that the “intermediary” of this passage or service provider of claim 1:

- “is not the patient or a covered entity” or
- will be “transmitting said converted medical record to a third party in the storage format as received from the patient,” or
- will be “transmitting said converted medical record . . . when the defined conditions occur.”

Joao, col. 41, lines 13-32 states:

Any and/or all of the data and/or information described herein, which is stored in the database 10H, or in the collection of databases, can be linked via relational database techniques and/or via any appropriate database management techniques. The data and/or information, in the preferred embodiments, can be updated via inputs from any of the computers and/or communication devices 10, 20, 30, 40, and/or 50, and/or external computers or communication devices, described herein, in real-time, and/or via dynamically linked database management techniques. The above-described updates can also be provided from other information sources via the communication network.

The data and/or information which is stored in the database 10H and/or which may be otherwise utilized with, and/or in conjunction with, the apparatus and method of the present invention, can be linked via any suitable data linking techniques such as, for example, dynamically linked lists (DLLs), linked lists, and object links embedded (OLE's). Any suitable database management technique(s) may also be utilized in conjunction with the present invention.

This passage does not disclose that the “intermediary” of this passage or service provider of claim 1F:

- “is not the patient or a covered entity” or
- will be “transmitting said converted medical record to a third party in the storage format as received from the patient,” or

will be “transmitting said converted medical record . . . when the defined conditions occur.”

In short, Segal does not show at least the limitations of elements B through F of claim 1. Neither Segal nor Joao as relied upon in the Office action discloses the elements and limitations of any of elements 1D, 1E, or 1F of claim 1. Nor does the statement of Official Notice show the limitations of any part of claim 1 are in the prior art. The same basis provided for claim 1 has been relied upon by the Examiner respecting claims 19 and 30, so those rejections are overcome as well by the showing above. The dependent claims are patentable for the same reasons as their respective independent claims. Therefore, the present rejection cannot stand and should be withdrawn as to all of the claims.

35 U.S.C. § 132 (Amendments Supported)

Claims 1, 19, and 30 of the present application are amended only by deletion. The amendment of claim 64 is made to conform its antecedent reference to the terminology of claim 30, and is supported by claim 30. The amendments in this paper are therefore free of new matter.

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Conclusion

In view of the above remarks, the applicant respectfully requests reconsideration and allowance of all the pending claims (1, 5-30, and 32-64).

The Commissioner is hereby authorized to charge the fee for extension of time, a request for continued examination, and any additional fees or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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